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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/450,609	11/30/1999	HELLE WEIBEL	5739.200-US	7926

7590 03/25/2003

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EXAMINER

KIM, JENNIFER M

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/25/2003

22

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/450,609

Applicant(s)

WEIBEL ET AL.

Examin r

Jennifer Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondenc address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2002 .
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disp sition of Claims

- 4) ☒ Claim(s) 6,7,11-13,16 and 28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29-31 is/are allowed.
- 6) ☒ Claim(s) 6,7,11-13,16,28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____ .

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 27, 2002 has been entered.

The amendment filed December 2, 2002 have been received and entered into the application.

Response to Arguments

Applicant's arguments filed on December 2, 2002 have been fully considered but they are not persuasive.

1. Applicants argue that data shows nonobvious and unexpected result of the formulations containing microcrystalline cellulose with low moisture content (Avicel PH 112, formulation B and D) are more stable i.e. lower content of degradation products than the formulations containing microcrystalline cellulose with higher moisture content (Avicel PH 102, formulation A and C). However, this is not persuasive because Applicants' broad claims 6 and 9 read on the both sets of formulations (B and D) and (A and C). The "evidence" of alleged nonobvious and unexpected result is not

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commensurate in scope with the breadth of the claims. It is noted that Applicant's alleged nonobvious and unexpected results is only encompassed by the specific formulation of B and D not the claims drawn to broad class of a microcrystalline cellulose.

2. The declaration Under 37 C.F.R. 1.132 by Thyge Borup Hjorth have been carefully reviewed and considered. However, the results of alleged nonobvious and unexpected result of stability is not commensurate in scope with the breadth of the claims.

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.

In view of the above Office Action of July 03, 2001 is deemed proper and asserted with full force and effect herein to obviate applicants' claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 6, 7, 9, 11-13, 16, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lohray et al.(WO 9741097) in view of Sohda et al.(U.S.Patent No.5972971).

Lohray et al. teaches at page 35, example, applicants' composition in a tablet form.

Lohray et al. at page 34, lines 27-29, page 35, example, and page 7, lines 13-14, teach pharmaceutical composition containing applicants' active agent in tablet, capsule, or powder form, in combination with the pharmaceutically acceptable excipient set forth in claim 8-10, and flavourants, sweeteners set forth in claim 16, and other media normally employed in preparing such compositions.

Sohda et al. at abstract and column 10, lines 20-21, teach anti-diabetic agent containing anti-oxidants, preferably ascorbic acid. Sodha et al. also teach at column 9, lines 55-65, the anti-diabetic agent containing applicants' excipient such as lactose, mannitol, starch,

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crystalline cellulose, silicone dioxide, magnesium stearate, and hydroxy propyl methyl cellulose.

The difference between the primary reference and applicants' claimed invention is the presence of anti-oxidant set forth in claims 6, 14, and 15, and the proportions set forth in claims 8 and 9. However, to incorporate anti-oxidant to the primary reference would have been obvious to a person of ordinary skill in view of Sohda et al. who teach antidiabetic agent containing anti-oxidant and the other excipient. One of ordinary skill in the art would have been motivated to combine anti-oxidants to the above composition since Lohray et al. teach other media normally employed can be incorporated and anti-oxidant is normally incorporated by Sohda et al. in formulating anti-diabetic agent.

The proportions of active agents to be used, and adjusting water content of excipient are all deemed obvious since they are all within the knowledge of the skilled pharmacologist.

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.

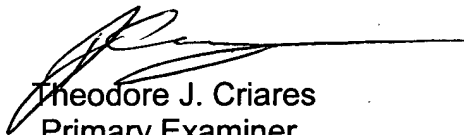
Allowable Subject Matter

Claims 29-31 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 703-308-2232. The examiner can normally be reached on Monday through Friday 8:30am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Theodore J. Criares
Primary Examiner
Art Unit 1617

jmk
March 21, 2003